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Kevin Lynn Wildenstein
Snell & Wilmer L.L.P.
One Arizona Center
400 East Van Buren
Phoenix, AZ 85004-2202

EXAMINER	
LABAZE, EDWYN	
ART UNIT	**PAPER NUMBER**
2876	

DATE MAILED: 02/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/924,025	BIGGAR ET AL.	
	Examin r	Art Unit	
	EDWYN LABAZE	2876	

-- The MAILING DATE of this communication appears on the cov r sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 August 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *5* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. This application claims the benefit of U.S. Provisional Patent Application number 60/272,487 filed on 2/27/2001.

2. Receipt is acknowledged of IDS filed on 1/04/2002.

3. Claims 1-48 are presented for examination.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1, 11-17, 23-29, 35-41, and 45-48 is rejected under 35 U.S.C. 102(e) as being unpatented by Flaig et al. (U.S. 6,488,206).

Re claim 1, 11, 16, 23, 27, 35, and 45: Flaig et al. discloses a method and apparatus for detecting and investigating fraudulent transactions in debit and charge card activations, which includes means or providing a notice/call to consumer to activate a card on a site/internet on a first computing system 12 in communication with a second computing system 18 over a first

network 16 (col.3, lines 31-42); instructing the consumer to access the web site (col.3, lines 43-50); prompting the consumer to provide predetermined card information to the site and communicating the predetermined card information to the second computing system over the first network (col.3, lines 54-63); processing, by the second computing system 18, the predetermined card information against previously stored account data in order to activate the card and generating process results (col.1, lines 53-65); and notifying the consumer on the first computing network of the processing results (col.4, lines 10-14), further comprising of means for allowing the global computer network 10 to process the predetermined card information to generate activation results (col.1, lines 49-54); and transmitting the activation results to the cardholder on the first computing network 12 (col.1, lines 58-65); also comprising of an interactive device activation web site in communication with a consumer's computer system (col.7, lines 14-25) .

Re claims12, 36, and 46: Flaig et al. discloses an apparatus and method, wherein the global computer network being the Internet (col.3, lines 39-43; col.7, lines 14-18).

Re claims13, 37, and 47: Flaig et al. teaches an apparatus and method, wherein the step of allowing the second computing system to generate an online card activation decline/failure message to the consumer on the first computing system if the card cannot be activated for any predetermined reason, presenting to the consumer on the first computing system the opinion of manually calling the provider and the opinion of interactively communicating with the provider on the first computing system (col.2, lines 8-19; col.4, lines 39-58;and col.6, lines 30-44).

Re claims14, 38, and 48: Flaig et al. discloses an apparatus and method, wherein the step of allowing the second computing system to process the predetermined card information further

comprising of processing the predetermined card information by fraud rule processing (col.6, lines 45-67 and col.7, lines 1-25).

Re claim 15, 39: Flaig et al. teaches an apparatus and method, wherein the step of allowing the second computing system to determine whether the consumer is a member of an existing provider service by prompting the consumer to submit service identification data to the second computing system (col.4, lines 14-28), allowing the second computing system to validate the service identification data and authenticate the existing provider service if the consumer's membership is valid, and notifying the consumer on the first computing network of the second computing system's provider service authentication results (col.5, lines 1-22).

Re claims 17, 24, 40, 41: Flaig et al. discloses an apparatus and method, wherein the site further receiving from the computer system a cardholder's name 39, account number 35 and card identification number 37 as part of the predetermined card information (col.2, lines 44+ and col.4, lines 17-20), the web site further storing/logging 29 the card information and processing the information for activation (col.2, lines 20-26), fraudulent entries (col.7, lines 26+), erroneous entries (col.10, lines 45-46) and further performing validation checks on cardholder supplied data (col.4, lines 13-14), performing dynamic authentication processing on cardholder supplied data (col.3, lines 53-59), utilizing a cardholder's electronic mail address 262 for transmitting the activation results and generating at least one hyperlink on the computer system corresponding to related provider card services (col.6, lines 11-29).

Re claim 25: Flaig et al. teaches an apparatus and method, wherein the step of allowing the second computing system to generate an online card activation decline/failure message to the consumer on the first computing system if the card cannot be activated for any predetermined

reason, presenting to the consumer on the first computing system the opinion of manually calling the provider and the opinion of interactively communicating with the provider on the first computing system (col.2, lines 8-19; col.4, lines 39-58;and col.6, lines 30-44).

Re claim 26: Flaig et al. teaches an apparatus and method, wherein the step of allowing the second computing system to determine whether the consumer is a member of an existing provider service by prompting the consumer to submit service identification data to the second computing system (col.4, lines 14-28), allowing the second computing system to validate the service identification data and authenticate the existing provider service if the consumer's membership is valid, and notifying the consumer on the first computing network of the second computing system's provider service authentication results (col.5, lines 1-22).

Re claim 28: Flaig et al. teaches an apparatus and method, wherein the activation results being generated by the second computing system 18 by processing the predetermined card information against previously stored account data (col.5, lines 18-57).

Re claim 29: Flaig et al. teaches an apparatus and method, wherein the step of allowing the second computing system to generate an online card activation decline/failure message to the consumer on the first computing system if the card cannot be activated

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 2-3, 5-10, 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flaig et al. (U.S. 6,488,206) in view of Risafi et al. (U.S. 6,473,500).

Re claims 2-3, and 18: The teachings of Flaig et al. have been discussed above.

Flaig et al. fails to teach a third computing system in communication with a second computing network.

Risafi et al. discloses a system and method for using a prepaid card, which includes a second computing network system 108 (col.10, lines 18-31).

In view of Risafi et al.'s teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate a second computing system, such as a bank or card issuer, with direct connections between the retailer/merchant and the bank/card issuer in order to authenticate the validity of card information provided by the cardholder. In addition, such connection would prevent the use of fraudulent or stolen cards through the internet system, assure security of legal cardholder, and allows business transactions through verification of personal or secure information by the second computing network. Furthermore, such modification would have an obvious extension as taught by Flaig et al., therefore an expedient.

Re claim 5: Flaig et al. discloses an apparatus and method, wherein the global computer network being the Internet (col.3, lines 39-43; col.7, lines 14-18).

Re claim 6: Flaig et al. teaches an apparatus and method, wherein the first computing system is a personal computer (col.3, line 38).

Re claim 7: Flaig et al. discloses an apparatus and method, wherein the notice or message corresponding to a new card notice, a renewal card notice or a replacement card notice (col.4, lines 54-58).

Re claims 8, 20: Flaig et al. teaches an apparatus and method, wherein the step of allowing the second computing system to generate an online card activation decline/failure message to the consumer on the first computing system if the card cannot be activated for any predetermined reason, presenting to the consumer on the first computing system the opinion of manually calling the provider and the opinion of interactively communicating with the provider on the first computing system (col.2, lines 8-19; col.4, lines 39-58;and col.6, lines 30-44).

Re claims 9, 21: Flaig et al. discloses an apparatus and method, wherein the step of allowing the second computing system to process the predetermined card information further comprising of processing the predetermined card information by fraud rule processing (col.6, lines 45-67 and col.7, lines 1-25).

Re claims 10, 22: Flaig et al. teaches an apparatus and method, wherein the step of allowing the second computing system to determine whether the consumer is a member of an existing provider service by prompting the consumer to submit service identification data to the second computing system (col.4, lines 14-28), allowing the second computing system to validate the service identification data and authenticate the existing provider service if the consumer's membership is valid, and notifying the consumer on the first computing network of the second computing system's provider service authentication results (col.5, lines 1-22).

Re claim 19: Flaig et al. teaches an apparatus and method, wherein the step of generating activation results further comprising the step of allowing the second computing system 18 to process the predetermined card information against previously stored account data in order to activate the card defining processing results (col.5, lines 18-57).

8. Claims 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flaig et al. (U.S. 6,488,206) in view of Chen et al. (U.S. 5,694,471).

Re claim 30: The teachings of Flaig et al. have been discussed above, further includes means for evaluating whether the card information passes fraud processing rules (col.5, lines 41-50).

Flaig et al. fails to teach a method for determining whether the card information belongs or corresponds to a pre-existing provider.

Chen et al. discloses a counterfeit-proof identification card, which includes means for determining whether the card information belongs or corresponds to a pre-existing provider service or issuer (col.7, lines 34-67 and col.8, lines 1-27).

In view of Chen et al.'s teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate a subroutine into the network as taught by Flaig et al. with means of determining whether the card information corresponds to a pre-existing provider in order prevent fraud and use of illegal replica of card. Furthermore, such improvement would enforce the security and authentication of the cardholder's information and match the information to the legitimate cardholder prior to activating a card request online or the World Wide Web. Moreover, such modification would have been an obvious modification of the teaching of Flaig et al.

Re claim 31: Flaig et al. teaches an apparatus and method, wherein the step of allowing the second computing system to generate an online card activation decline/failure message to the consumer on the first computing system if the card cannot be activated for any predetermined reason (col.4, lines 47-58; and col.8, lines 50-67; col.9, lines 1-18), and allowing the second

computing system to generate a card already activated message/report to the cardholder on the first computing system if the card is determined by the second computing system to have been already activated (col.10, lines 50-67).

Re claim 32: Flaig et al. discloses an apparatus and method, wherein the fraud processing rules further comprising the steps of gathering cardholder information data from card issuance (col.5, lines1-3), authorization, and billing or payment systems and databases accessible by the second computing, applying the cardholder data to the fraud processing rules (col.7, lines 25-44), displaying online card activation decline message to the cardholder on the first computing system if the information provided does not correspond to the provider's data (col.5, lines 4-14), analyzing system data to initially determine whether authentication data is available (col.5, lines), and if authentication data is available, transmitting predetermined questions to the first computing system for display to the cardholder to authenticate that the cardholder corresponding to the card by predetermined identifiers (col.9, lines 54-67 and col.10, lines 1-20).

Re claim 33: Flaig et al. discloses an apparatus and method, wherein the step of allowing the second computing system to prompt the cardholder via first computing system for cardholder authentication information if the card is not already registered/activated or look-up 90 at step 94 (col.4, lines 59-67).

9. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Flaig et al. (U.S. 6,488,206).

The teachings of Flaig et al. have been discussed above.

Flaig et al. fails to teach an option for the cardholder to enroll in other provider/issuer services.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate a subroutine/segment allowing the cardholder the option of enrolling with other service providers. Furthermore, such modification would be advantageous to the cardholder so that the user can compare the different rates and service charges, terms of agreement, length of contract and much more when choosing to activate an item/device when the service provider/issuer. In addition, such modification would have been an obvious modification as taught by Flaig et al.

10. Claims 4, 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flaig et al. (U.S. 6,488,206) as modified by Risafi et al. (U.S. 6,473,500) in view of Dosch (US. 2002/00693664).

The teachings of Flaig et al. as modified by Risafi et al. have been discussed above.

Flaig et al. as modified by Risafi et al. fails to teach a wireless transmission, and a device being a cellular phone, and a transponder.

Giordano teaches an Internet terminal with identification module, which includes a transponder 15 (page 2, col.4, paragraph 0027), cellular phone 51 (page 3, col.6, paragraph 0034).

In view of Dosch's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to provide online activation of other devices such as cellular phones, transponder. Furthermore, such modification would be beneficial to the services providers/issuers and financial institutions so as to prevent fraudulent activation, authentication of predetermined information when activating these devices over the Internet, and operation of illegal devices conducting business transactions over the Internet where billing and payment

activities can be performed without visual and/or written authorization from the provider/issuer. Moreover, such modification would have been an obvious modification of the teaching of Flaig et al., thus an expedient.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Arditti et al. (US 2003/0014360) discloses service activation by virtual prepaid card.

Tsiounis et al. (US 2001/0032878) teaches method and system for making anonymous electronic payments on the World Wide Web.

Epstein (US 2003/0004828) discloses prepaid card authorization and security system.

Sutton et al. (US 2002/0120530) teaches method and system for transacting anonymous purchase over the Internet.

Giordano et al. (US 2002/0152123) discloses system and method for processing financial transactions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (703) 305-5437. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

el
Edwyn Labaze
Patent Examiner
Art Unit 2876
February 6, 2003

Diane I. Lee
Primary Examiner
GAU 2876